

C. Remarks

The claims are 1-3, 10-13, 30 and 35, with claim 1 being the sole independent claim. Claims 5 and 31-34 have been cancelled. Claim 2 has been amended to be directed solely to the structural unit of Formula (2). New claim 35 has been added to recite a structural unit of Formula (3), which has been removed from claim 2. No new matter has been added. Reconsideration of the present claims is expressly requested.

Claims 5 and 31-34 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. Since these claims have been cancelled, the indefiniteness rejection is moot and should be withdrawn.

Claims 1-3, 5, 10-13 and 30-34 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,525,446 (Sypula). The grounds of rejection are respectfully traversed.

The present invention is related to an endless belt, which has a single-layer structure. This belt should have sufficient durability and performance characteristics, such as a resistance of 1×10^0 to $1 \times 10^{14} \Omega$, to be an intermediate transfer member for electrophotography.

Sypula discloses an intermediate transfer member for an electrophotographic system. Sypula, however, does not disclose or suggest an intermediate transfer member having a single-layer structure as presently claimed. Specifically, the intermediate transfer member in Sypula has a film base layer and a top thermoplastic film forming polymer layer, which are bonded together by an adhesive, i.e., a multi-layer structure. Furthermore, this reference fails to disclose or suggest an endless belt having a

single-layer structure that has durability and transfer properties, e.g., a resistance of 1×10^0 to $1 \times 10^{14} \Omega$, which allow it to be used as an intermediate transfer member of an electrophotographic system.

The Examiner has alleged that it would have been obvious to one of ordinary skill in the art to separate the endless belt in Sypula to form a single layer structure. To support this conclusion, the Examiner relied on Nerwin v. Erlichman, 168 U.S.P.Q. (BNA) 177, 179 (P.O.B.P.I. 1969). Applicants respectfully submit that the Examiner's conclusion is incorrect as a matter of law.

As a matter of law, the modification of Sypula proposed by the Examiner must be suggested by the prior art. See In re Gordon, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 277 U.S.P.Q. (BNA) 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added).

Applicants respectfully submit that neither of the above-mentioned benchmarks for showing that the modification of Sypula would have been obvious was met by the Examiner. Specifically, the required suggestion or motivation for the modification

is absent in Sypula and the Examiner has not presented a "convincing line of reasoning" to show obviousness. The Examiner's statement that the modifications of Sypula to meet the claimed invention would have been obvious to one of ordinary skill in the art is not sufficient to establish a prima facie case of obviousness without some objective reason. See Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); Al-Site Corp. v. VSI Int'l Inc., 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999). The Nerwin v. Erlichman case relied upon by the Examiner cannot serve as an "objective reason". This case concerns the interpretation of what constitutes an element in the context of a count in an interference. See Nerwin v. Erlichman, 168 U.S.P.Q. (BNA) 177 (P.O.B.P.I. 1969). At most, this case indicates that the belt in Sypula consists of two separate elements, a top layer and a base layer. It has no bearing on motivation or suggestion for the separation of layers.

Sypula is directed to at least a two-layer structure in which each layer performs a designated function. For example, Sypula states that "[t]he top layer has the proper electrical properties for charge dissipation which is necessary for toner image transfer." (Col. 2, lines 43-44). Thus, removing the top layer would deprive the belt of a function Sypula considers necessary. This function is not disclosed to be compensated for by the base layer. Consequently, if the top layer is removed and the remaining base layer taught by Sypula cannot function as a toner transfer member in an electrophotographic apparatus, Sypula cannot render the presently claimed invention unpatentable.

Furthermore, as stated in M.P.E.P. 2111.04(II)(B), "omission of an element and retention of its function is an indicia of non-obviousness" (emphasis added). Thus, even if the base layer in Sypula could function as a transfer member without the top layer, a

previously undisclosed retention of its necessary functionality prevents Sypula from rendering the presently claimed invention obvious. See In re Edge, 149 U.S.P.Q. (BNA) 556 (C.C.P.A. 1966). The Examiner's reliance on Applicants' disclosure regarding the fact that the belt can have one or more layers is impermissible hindsight reasoning, which cannot be used to show a suggestion or motivation to modify Sypula. Accordingly, it is clear that the Examiner has not established a prima facie case of obviousness with respect to Sypula.

In conclusion, Applicants respectfully submit that Sypula does not disclose or suggest the presently claimed single-layer endless belt. In fact, Sypula teaches away from it. Specifically, Sypula teaches away from removing the top layer and retaining a single-layer structure, because, according to Sypula, the top layer performs a necessary function.

Wherefore, Applicants respectfully submit that the presently claimed invention is patentable over Sypula and request that the outstanding rejections be withdrawn and the present case be passed to issue.

This Amendment After Final Rejection should be entered, because it places the case in allowable form. Alternatively, it places the case in better form for a possible appeal. The amendment to claim 2 and the addition of claim 35 clearly do not introduce new issues requiring further consideration and/or a new search. Furthermore, while adding only one claim, Applicants cancelled five finally rejected claims.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our

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Respectfully submitted,


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